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Remarks

Claims 1 through 6 remain pending in the application.

Claim Rejections - 35 U.S.C. §103 (Chu)

The Office Action rejects claim 1, 5 and 6 as obvious over Chu et al., Method and Apparatus for Severing and Capturing Polyps, U.S. Patent 6,010,512 (Jan. 4, 2000). The Office Action Asserts Chu discloses the system and method claimed by the Applicant, but fails to disclose a heating element. Further, the Office asserts it would have been obvious to modify Chu by incorporating a heating element along the snare cable which would be tantamount to the Applicant's claimed invention. The Office Action asserts the motivation to one of ordinary skill is to provide the added benefit of cauterizing along the snare cable providing a cleaner cut and detachment of the polyp. The Office action is failing to provide a prima facie case of obviousness. Further, the Office Action is failing to fully consider the Applicant's claim limitations. Therefore, withdrawal of this rejection is respectfully requested.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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Chu provides no inherit or explicit motivation or suggestion for the Applicant's claimed invention. Further, there is no inherit motivation in the art as the Office Action suggests. The severing device 13 in Chu is used to initially snare and then severe the polyp. (Figure 1, col. 5, lines 43-66) Jaws 40 in Chu are used to then grasp and remove the severed polyp. In the Applicant's system, a snare cable routed through the jaws is used to initially grasp a polyp. The jaws in the Applicant's claimed invention are used to then severe the polyp and cauterize the cut. Since Chu does not severe the polyp with jaws, there is no motivation to dispose a heating element in at least one of the jaws as claimed by the Applicant. A simple statement that "cauterization provides a cleaner cut" is not a motivation to dispose a heating element on at least one of the jaws as claimed by the Applicant. Even if a heating element were disposed within the severing device 13 in Chu as suggested by the Office Action, the resulting device would not result in the Applicant's claimed invention.

Chu fails to teach or suggest all the claim limitations of the Applicant's claimed invention. The Applicant's claimed invention does not dispose a heating element on a snare cable as suggested by the Office Action. The Applicant claims in claims 1, 5 and 6, *inter alia*, a heating element disposed on at least one of the jaws. The Applicant also claims a snare cable routed through the pair of jaws. Chu does not rout a snare cable through the pair of jaws. The Office Action states that "Incorporating a heating element along the snare cable which would be tantamount to the Applicant's claimed invention." The Office Action's conclusion that incorporating a heating element along the snare cable would be tantamount to the Applicant's claimed invention is incorrect, unfounded and improper as a substitute for the required analysis of patentability. The case of Graham v. John Deere Co., 383 U.S. 1 (1966), eliminates application of all such maxims in favor of the mandated test for patentability. Not only does the

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Applicant not claim a heating element disposed in the snare cable, but a rejection based on design considerations from the Office Action appears to be offered as a substitute for the test required by Graham v. John Deere, which is improper. Graham v. John Deere requires identification of some pre-existing motivation to combine prior art references to achieve the claimed combination. There is no rational basis for application of such an assertion, and this assertion deprives the Applicant of his right to have his application considered under uniform standards on par with all other applicants.

The Office Action further rejects Applicant's claim 2. Contrary to the Office Action's assertion on page 5, Chu fails to disclose a nichrome wire heating element, a ceramic heating element, an RF heating element, or a bipolar electrode heating element. Chu merely discloses use of the snare 70 as a monopolar electrode. The Applicant does not claim a heating element in a snare cable.

Because there is no motivation to combine or modify Chu, because Chu fails to disclose the Applicant's claimed invention, and because any modification of Chu would not result in the Applicant's claimed invention, Chu does not render the Applicant's claims obvious. For at least these reasons, withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103 (Chu & Stati)

The Office Action rejects claim 4 as obvious over Chu et al., Method and Apparatus for Severing and Capturing Polyps, U.S. Patent 6,010,512 (Jan. 4, 2000) in view of Stati et al., Method of Inhibiting Blood Clot on Silicone Rubber Medical Devices, U.S. Patent 3,829,903 (Aug. 20, 1974). The combination of Chu and Stati fails to disclose the Applicant's claimed invention. Therefore, withdrawal of this rejection is respectfully requested.

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The requirements for establishing a prima facie case of obvious are discussed supra. Stati is directed towards a method of inhibiting blood clots on the surface of silicone rubber medical devices. Stati fails disclose a pair of jaws extending out of the distal end of the catheter and a heating element disposed on at least one of the jaws and located between the pair of jaws in its specification. Chu also fails to disclose a pair of jaws extending out of the distal end of the catheter and a heating element disposed on at least one of the jaws and located between the pair of jaws as previously discussed.

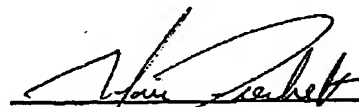
Since Chu and Stati each fail to disclose at least one common limitation recited in claim 4, it follows that the combination of both references fails to disclose the invention recited in claim 4. As such, claim 4 is patentable over Chu in view of Stati.

Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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